



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/576,117

04/18/2006

Ulrich Bohne

3628

4805

7590  
Striker, Striker & Stenby  
103 East Neck Road  
Huntington, NY 11743

11/12/2009

EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

11/12/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/576,117 | <b>Applicant(s)</b><br>BOHNE, ULRICH |  |
|                              | <b>Examiner</b><br>Clark F. Dexter   | <b>Art Unit</b><br>3724              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The amendment filed on June 26, 2009 has been entered.

### ***Election/Restrictions***

2. Newly submitted claim 12 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The Inventions of Group II (claim 12) and Group I (claims 1-11) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, as best understood from the method claim, the process as claimed can be practiced by another and materially different apparatus or by hand, and the apparatus as claimed can be used to practice another and materially different process.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 12 has been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Objections***

3. Claims 1-10 are objected to because of the following informalities:

In claim 1, line 5, the reference to numerals 7 and 16 is inaccurate because they are directed to features of embodiments that do not correspond to the subject claims and these numerals should be deleted.

In claim 3, line 2, the reference to numeral 10 is inaccurate and should be deleted; in line 4, the reference to numerals 8 and 17 is inaccurate and should be deleted.

In claim 7, line 3, the reference to numeral 24 is inaccurate and should be deleted; in line 4, the reference to numerals 12 and 16 is inaccurate and should be changed to --12, 13--.

In claim 9, line 1, it seems that "having" should be changed to --further comprising-- for clarity; in line 3, the reference to numeral 24 is inaccurate and should be deleted.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3724

5. Claims 4-6, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, line 4, the recitation “a respective lateral boundary line” is vague as to whether it includes that set forth in claim 1 or other such lines, and further lacks positive antecedent basis because it appears to refer to multiple boundary lines but only one has been previously set forth.

In claim 5, line 1, “30°” renders the claim vague and indefinite as to what is being set forth since it is outside the range established in claim 1 from which claim 1 ultimately depends.

In claim 11, line 12, the recitation “the straight section of the circle segment” is vague and indefinite as to what is being set forth since a circle does not include straight sections.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Publication 52-18281 (hereafter JP '281).

Art Unit: 3724

Regarding claims 1-10, JP '281 discloses a tool unit (e.g., see Figs. 3-5 and 7) with every structural limitation of the claimed invention including:

a fastening means (e.g., 9) for attachment to the output unit; a working edge and a first lateral boundary line (e.g., an imaginary line from each end of the working edge to the center of aperture 9),

wherein the working edge transitions into the first lateral boundary line,

wherein the working edge is arc-shaped, and

wherein the working edge extends with respect to a center of the fastening means over an angle being between 180° and 270°;

[claim 2] wherein the arc-shaped working edge is constituted by the circumference of a circle around whose center point the fastening means is situated;

[claim 9 (from 2)] having a second lateral boundary line, wherein the working edge is constituted by the circumference of a circle segment, and a first end of the working edge transitions in the first lateral boundary line, wherein a second end of the working edge transitions into the second lateral boundary line, wherein the first lateral boundary line extends in a first radial direction and the second lateral boundary line extends in a second radial direction, wherein the fastening means is constituted by an aperture (e.g., 9), wherein the first lateral boundary line comprises at least a straight part, and wherein at least one end of said working edge is situated at an angle of less than or equal to 90° in relation to said partially straight first lateral boundary line on at least one side;

[claim 3] wherein at least one end of the working edge is situated at an angle of less than or equal to  $95^\circ$  in relation to at least one of the first lateral boundary line and a second lateral boundary line (e.g., in JP '281, the angle is less than  $95^\circ$ );

[claim 4] wherein the working edge is constituted by the circumference section of a circle sector and each of the two ends of the working edge is situated at an angle in relation to a respective lateral boundary line extending in the radial direction;

[claim 5 (from 4)] wherein the circle sector extends over an angular range of between  $30^\circ$  and  $270^\circ$ ;

[claim 6 (from 4)] wherein the radially extending boundary lines are connected to each other by means a connecting contour (e.g., the portion of the unit above the fastening means 9 and between the ends of the working edge) before they reach the center point;

[claim 10 (from 6)] wherein the fastening means is constituted by an aperture (e.g., 9);

[claim 7] wherein the working edge is constituted by the circumference of a circle segment and each of the two ends of the working edge is situated at an angle in relation to a respective lateral boundary line, each of which is essentially constituted by the straight section of the circle segment;

[claim 8] wherein the working edge (4) is provided with saw teeth.

Regarding claim 11, JP '281 discloses a tool unit (e.g., see Figs. 3-5 and 7) with every structural limitation of the claimed invention including:

a fastening means (e.g., 4) for attachment to the output unit;

a working edge; and

a first lateral boundary line and a second lateral boundary line, wherein the working edge transitions into the first and the second lateral boundary lines (e.g., the imaginary lines from each end of the working edge to the center of aperture 9),

wherein the working edge is arc-shaped,

wherein the working edge is constituted by the circumference of a circle segment and each of the two ends of the working edge is situated at an angle in relation to one of the lateral boundary lines, each of which is essentially constituted by the straight section of the circle segment, wherein the fastening means is constituted by an aperture (e.g., 9).

### ***Response to Arguments***

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/  
Primary Examiner, Art Unit 3724**

cfd  
November 9, 2009